

REMARKS

Claims 1–11, 13–16, 18, and 20–22 remain under consideration. Claims 1 and 13–16 have been amended, claims 12, 17, and 19 have been cancelled and claims 23–28 have been added. The Examiner has stated that claims 8–10 and 16 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. New independent claim 23 includes the limitations of original independent claim 1, dependent claim 8, and intervening claim 6. New independent claim 24 includes the limitations of original independent claim 1, dependent claim 9, and intervening claim 6. New independent claim 27 includes the limitations of original independent claim 1, dependent claim 10, and intervening claims 6 and 9. New independent claim 28 includes the limitations of original independent claim 1, dependent claim 16, and intervening claims 12 and 15. No new matter was added with the amendment.

A. Claims 1–7, 12, 15, 17, 18, and 20–22 were provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1–14 of copending Application No. 10/418,457 [sic].

Examiner Mendoza provisionally rejected claims 1–7, 12, 15, 17, 18, and 20–22 under 35 U.S.C. §101 as claiming the same invention as that of claims 1–14 of copending Application No. 10/418,457. The copending application is No. 10/419,457. This rejection is traversed.

Applicants' independent claim 1 has been amended to maintain a clear line of demarcation between the two applications. The limitation of original claim 19, "crimping the stent onto the balloon prior to introducing an adhesive material within the sheath," has been added to amended independent claim 1. Independent claim 1 of copending Application No. 10/419,457 does not include this limitation. Support for this limitation can be found on page 10, lines 20 and 21 of the present application. Thus, no new matter is added with the amendment.

Original claims 2–11, 18, and 20–22 depend from amended independent claim 1. Claims 13–16 have been amended to depend from amended independent claim 1. Therefore, dependent claims 2–11, 13–16, 18, and 20–22 include all of the elements and limitations of amended independent claim 1. It is therefore respectfully submitted by the Applicants that dependent claims 2–11, 13–16, 18, and 20–22 are allowable for at least the same reasons as set forth herein with respect to amended independent claim 1. Withdrawal of the provisional rejection of dependent claims 1–7, 12, 15, 17, 18, and 20–22 under 35 U.S.C. §101 as claiming the same

invention as that of claims 1–14 of copending Application No. 10/419,457 is respectfully requested.

B. Claims 1–3, 5, 6, 12, 13, 15, and 18–20 were rejected under 35 U.S.C. §102(b) as being anticipated by Yan (6,066,156).

Claims 1–3, 5, 6, 12, 13, 15, and 18–20 were rejected under 35 U.S.C. §102(b) as being anticipated by Yan (6,066,156). This rejection is traversed.

“[F]or anticipation under 35 U.S.C. §102, a single reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.” [MPEP §706.02.] “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With regard to the Applicants’ amended independent claim 1, at a minimum, Yan does not teach “removing the sheath after cooling the adhesive material.” This limitation of the invention is claimed in original dependent claim 17 and has been added to amended independent claim 1 to more particularly point out and distinctly claim the Applicants’ invention. Support for this limitation can be found on page 12, lines 13 and 14. Thus, no new matter has been added by the amendment of the claim. On page 4 of the Office Action dated September 8, 2004 for copending Application No. 10/419,457, the Examiner determined that this limitation would be allowable over Yan if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Thus, the Examiner has already determined that this limitation is not taught by Yan. The limitation of intervening original claim 12, “positioning a sheath over the stent prior to application of the adhesive material,” has also been added to claim 1. Support for the limitation of intervening original claim 12 can be found on page 10, lines 22 and 23. Thus, no new matter has been added by the amendment of the claim.

For at least the reasons stated above, Yan does not teach every aspect of the Applicants’ pending independent claim 1. Therefore, the rejection of this claim must fall. Withdrawal of the rejection of independent claim 1 under U.S.C. §102(b) as being anticipated by Yan is therefore respectfully requested.

Original claims 2–11, 18, and 20–22 depend from amended independent claim 1. Claims 13–16 have been amended to depend from amended independent claim 1. Therefore, dependent claims 2–11, 13–16, 18, and 20–22 include all of the elements and limitations of amended

independent claim 1. It is therefore respectfully submitted by the Applicants that dependent claims 2–11, 13–16, 18, and 20–22 are allowable for at least the same reasons as set forth herein with respect to amended independent claim 1. Withdrawal of the rejection of dependent claims 2–11, 13–16, 18, and 20–22 under U.S.C. §102(b) as being anticipated by Yan is respectfully requested.

The Examiner states that claims 18 and 19 are product-by-process claims. Claim 18 of the present invention is a method claim that depends from amended independent claim 1. Claim 19 of the present invention is a method claim that has been cancelled, the limitation of claim 19 having been added to amended independent claim 1 as described above. Withdrawal of the rejection of dependent claims 18–19 under U.S.C. §102(b) as being anticipated by Yan is respectfully requested.

C. Claims 4 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yan (6,066,156) in further view of Phan et al. (5,674,242).

The rejections of claims 4 and 14 are traversed. Claims 4 and 14 depend from amended independent claim 1. It is therefore respectfully submitted by the Applicants that dependent claims 4 and 14 are allowable for at least the same reasons as set forth herein with respect to amended independent claim 1. Any claim depending from a non-obvious claim is also non-obvious. See MPEP 2143.03 and *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (where an independent claim is non-obvious, any claims depending there from are also non-obvious). Withdrawal of the rejections of dependent claims 4 and 14 under U.S.C. §103(a) as being unpatentable over Yan in further view of Phan et al. is therefore respectfully requested.

With further regard to claim 4, the Applicants have not stated that the adhesive of their invention “allows release of the stent in the presents [*sic*] of water” (page 4 of the Office action) nor do they intend to limit their invention in this way.

D. Claims 8–10 and 16 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten as indicated.

Claims 8–10 and 16 depend from amended independent claim 1 and include all of the elements and limitations of independent claim 1. It is therefore respectfully submitted by the Applicants that dependent claims 8–10 and 16 are allowable for at least the same reasons as set forth herein with respect to independent claim 1.

In addition, a new independent claim 23 has been added that includes the limitations of original independent claim 1, dependent claim 8, and intervening claim 6. Support for the limitation of dependent claim 8 can be found on page 11, lines 9 and 10, while support for the limitation of intervening original claim 6 can be found on page 11, lines 7 and 8. Thus, no new matter has been added with these claims.

A new independent claim 24 has been added that includes the limitations of original independent claim 1, dependent claim 9, and intervening claim 6. Support for the limitation of dependent claim 9 can be found on page 11, lines 10 and 11, while support for the limitation of intervening original claim 6 can be found on page 11, lines 7 and 8. New claims 25 and 26, which are dependent upon new independent claim 24, have also been added. These claims reflect the limitations of original claims 3 and 4, respectively. Thus, no new matter has been added with these claims.

A new independent claim 27 has been added that includes the limitations of original independent claim 1, dependent claim 10, and intervening claims 6 and 9. Support for the limitation of dependent claim 10 can be found on page 11, lines 10–14. Support for the limitation of intervening original claim 6 can be found on page 11, lines 7 and 8, while support for the limitation of intervening original claim 9 can be found on page 11, lines 10 and 11. Thus, no new matter has been added with these claims.

A new independent claim 28 has been added that includes the limitations of original independent claim 1, dependent claim 16, and intervening claims 12 and 15. Support for the limitation of dependent claim 16 can be found on page 11, lines 16–21. Support for the limitation of intervening original claim 12 can be found on page 10, lines 22 and 23, while support for the limitation of intervening original claim 15 can be found on page 11, lines 15 and 16. Thus, no new matter has been added with these claims.

Therefore, new claims 23-28 are allowable over the prior art for at least the same reasons as stated above.

CONCLUSION

The Examiner's rejections have been obviated by the above amendments and remarks. The Applicants respectfully submit that claims 1-11, 13-16, 18, and 20-28 fully satisfy the requirements of 35 U.S.C. §§101, 102, 103 and 112. In view of the foregoing amendments and remarks, favorable consideration and passage to issue of the present application are respectfully requested. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-0221.

Respectfully submitted,

A handwritten signature in black ink, reading "Catherine C. Maresh". The signature is written in a cursive style with a horizontal line underneath.

Catherine C. Maresh
Registration No. 35,268
Attorney for Applicant

Medtronic Vascular, Inc.
3576 Unocal Place
Santa Rosa, CA 95403
Facsimile No.: (707) 543-5420